

### **REMARKS**

Claims 1-24 are pending in this application. Claims 1, 7, 9, and 18 have been amended. No new matter has been added. Applicant reserves the right to pursue original and other claims in this and other applications.

I. The Objections to the Drawings Should be Withdrawn.

The drawings submitted by Applicant with the Amendment filed on December 14, 2007, are objected to in the Office Action under 35 U.S.C. § 132(a), allegedly because the drawings “introduce new matter into the disclosure of the invention.” Applicant respectfully traverses the objection.

The amended drawings do not introduce new matter to the Specification. The amended drawings were submitted by Applicant to obviate Examiner’s objection to the original drawings under 37 C.F.R. § 1.83(a), asserted in the Office Action of September 14, 2007. The amended drawings modify the labeling on steps S3 and S4 on each of the flow charts of Figs. 6-11. Step S3 is now labeled “Rotating at Speed Suitable for User’s Request?”; S4 is labeled “Changing Speed of Spindle Motor.”

Applicant submits that the steps of “Rotating at Speed Suitable for User’s Request?” (S3) and “Changing Speed of Spindle Motor” (S4) as illustrated in the flow charts of Figs. 6-11 are fully disclosed by the original specification, and thus are not new matter.

The Office Action asserts that the amended drawings “represent new matter added to the disclosure as amended to the figure drawings, and find no support in the original disclosure.” Office Action of Jan. 1, 2008, at page 3. In particular, the Office Action asserts that the original description in the specification discloses only “changing the rotation by checking whether the disc is rotating at a speed corresponding to the speed of storage and reproduction designated by the user request.” *Id.* (emphasis in original).

This assertion is untenable because of the explicit disclosure of the written description. The user request does not designate the specific rotation speed during the storage and reproduction processes. To the contrary, as will be explained below, the disclosure is clear that the user requests whether to store or reproduce data.

Applicant submits that the mistaken objection stems from a misreading of the cited written description. While the Office Action attempts to base the objection on certain selectively emphasized sentence fragments, *see* Office Action of Jan. 1, 2008, at page 3, this practice does not obviate the clear description of steps S3 and S4. To the contrary, lines 10 through 21 of page 16 of the Specification – cited in the Office Action as the basis for the objection – in fact make clear that the user's request is for the storage or reproduction of data, *not* the precise rotation speed at which they occur:

Formatting in the background begins (Step S1). The controller 13 checks whether the user requests to store or reproduce data (Step S2). If the user requests to do so (Y branch of S2), the controller 13 further checks whether the disc is rotating at a speed suitable for the storing and reproducing of the user's request (S3). If the disc is not rotating at a speed corresponding to the speed of storage and reproduction designated by the user (N branch of S3), the controller 13 changes the rotating speed of the spindle motor 4 through the rotation control unit 10 (S4).

Specification, page 16, lines 10-21 (emphasis added).

Were the description to end here, Applicant submits that the interpretation asserted in the Office Action would still be clearly erroneous in light of the disclosure. Yet the same paragraph continues:

The storing and reproducing of the user's request is performed (S5). The storage and reproduction requested by the user is controlled based on the CAV mode.

Specification, page 16, lines 21-24 (emphasis added). The descriptions of the other embodiments of Figs. 7-11 similarly include user requests for storage and/or reproduction operations, *not* specific

rotation speeds for those operations. *See* Specification at page 17, line 23 through page 18, line 2 (specifying that similarly labeled elements in Figs. 7-11 indicate similar steps).

Therefore, the amended drawings are merely adjusted to illustrate that which is disclosed in the written specification. The amended drawings are fully supported by the original disclosure – no new matter is added by the Amendment of December 14, 2007. Accordingly, Applicant respectfully requests that the objection to the amended drawings be withdrawn, and that the amended drawings be substituted for the original drawings in this application.

II. The Rejections of Claims 1-24 Should be Withdrawn.

Claims 1-24 stand rejected under 35 U.S.C. § 112, first paragraph, as containing subject matter not described in the specification. This rejection is respectfully traversed.

Independent claims 1 and 18, as amended, recite, *inter alia*, a method of storing data in a recording medium, comprising the step of:

if the first rotation mode is not suitable for the storing and reproducing of the user request, changing from the first rotation mode to a second rotation mode and writing the user data to the recording medium at the second rotation mode . . . .

Claims 2-8 and 19-21 depend from claim 1. Claim 24 depends from claim 18.

Similarly, independent claim 9 recites an information storage apparatus comprising, *inter alia*, a controller configured to, among other steps:

if the first rotation mode is not suitable for the storing and reproducing of the user request, rotate the recording medium at a second rotation mode and writing the user data to the recording medium at the second rotation mode . . . .

Claims 10-17 and 22-23 depend from claim 9.

Examiner asserts that the description fails to provide support for these limitations.

Examiner erroneously asserts that “[t]he specification describes changing the speed to that requested by the user.” Office Action of January 10, 2008, at page 4 (emphasis in original).

The specification makes no such disclosure. Rather, the specification clearly describes the user’s “request” as relating to the actions of storing or reproducing data. For example:

The controller 13 checks whether the user requests to store or reproduce data (Step S2). If the user requests to do so (Y branch of S2), the controller further checks whether the disc is rotating at a speed suitable for the storing and reproducing of the user’s request (S3). . . . The storing and reproducing of the user’s request is performed (S5). The storage and reproduction requested by the user is controlled based on the CAV mode.

Specification, page 16, lines 11-24 (emphasis added).

Applicant respectfully submits that Examiner’s interpretation is based upon a mistaken reading of a single clause in the written description. Examiner incorrectly reads the phrase “rotating at a speed corresponding to the speed of storage and reproduction designated by the user,” as meaning that “the speed” is “designated by the user.” Specification, at page 16, lines 16-19. The interpretation asserted in the Office Action fails to take into account references throughout the written description to user interaction requesting the storage and reproduction actions, *not* designating the speed at which these operations occur. *See, e.g.*, Specification at page 3, lines 17-20; page 3, lines 22-23; page 5, lines 16-19; page 8, lines 11-12; page 9, lines 8-12; page 10, lines 10-11.

As described in the specification, the ideal rotation mode during storage and reproduction is different than the ideal rotation mode during background writing. *See, e.g.*, Specification, page 4, lines 19-21. Speed is one non-limiting example of a “rotation mode.” Specification, page 7, line 21 through page 8, line 4. Therefore, as described in the Specification, in one embodiment of the invention the “controller 13 checks whether the user requests to store or reproduce data,” and “if the user requests to [store or reproduce data], the controller 13 further checks whether the disc is rotating at a speed suitable for the storing and reproducing of the user’s

Application No. 10/058,029  
Reply to Office Action of January 10, 2008  
Amendment of March 7, 2008

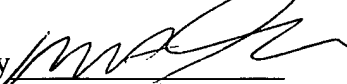
Docket No.: R2184.0132/P132

request (S3),” *not* whether the disc is rotating at a speed designated by the user. Specification, page 16, lines 11-16.

In view of the above, Applicant believes the pending application is in condition for allowance.

Dated: March 7, 2008

Respectfully submitted,

By 

Mark J. Thronson

Registration No.: 33,082  
DICKSTEIN SHAPIRO LLP  
1825 Eye Street, NW  
Washington, DC 20006-5403  
(202) 420-2200  
Attorney for Applicant